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<u>REMARKS</u>

Claims 1 to 100 were pending in the application at the time of examination. Claims 1 to 100 stand provisionally rejected for obviousness-type double patenting. Claims 1 to 100 stand rejected as anticipated.

Provisional Double Patenting Rejection in View of U.S. Patent Application Serial No. 10/687,488 (the '488 application).

The rejection stated in part "The subject matter in the instant application is fully claimed in the reference copending application and would be covered by any patent that granted on that copending application."

Applicant respectfully traverses the provisional obviousness-type double patenting rejection. The rejection fails to do a proper obviousness analysis which includes considering the claimed subject matter as a whole.

Claim 1 in the instant application requires that four different processes be performed on a user device. Claim 1 in the '488 application requires that seven different processes be performed on a user device. Accordingly, a party that performs only the four processes of Claim 1 cannot infringe Claim 1 of the '488 application because at least three of the seven processes of that application would not be performed.

When the claims are considered as a whole, as required by the MPEP, all limitations must be considered. The rejection simply reduces the claims to a gist, which the MPEP specifically cites as an improper form of analysis. The rejection has failed to cite any rationale for simply eliminating the three additional explicit claim limitations from the '488 application.

To render Claim 1 obvious based on Claim 1 of the '488 application, the rejection must provide some basis for eliminating the additional three processes of Claim 1 in

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the '488 application. The rejection has failed to provide such an analysis and so has not made a prima-facie obviousness rejection. For example, there has been no showing that Claim 1 of the '488 patent would still work for its intended purpose after the elimination of the additional processes.

Claim 10 of the '488 application is directed to processes performed by a rights locker provider and not processes performed on a user device as in Claim 1 of the instant application. The rejection failed to even acknowledge that the claims are directed to different entities. Again, the rejection has failed to explain how process performed by a rights locker provider renders obvious the processes of Claim 1. The rejection only compares Claim 1 in the instant application with Claim 1 in the copending applications.

The gist level of analysis in the rejection is further demonstrated by the blanket citation of all claims in the instant application as suggested by all the claims of the '488 application. Both Claims 10 and 15 in the instant application recite:

> determining, on a user device, a digital content specification and associated authenticated rights locker access request;
> sending, from said user device, said authenticated rights locker access request and said digital content specification;

The rejection has cited no Claim in the '488 application that includes or suggests these limitations and instead simply dismisses them as assessing the information in Claim 1. The rejection has failed to cite any teaching or suggestion based on the claims in the '488 application that two elements are determined and sent as recited in the above quoted elements. There is no discussion of such processes in the claims of '488 application. Accordingly, the superficial level of analysis failed to consider the claims as a whole. There is no rationale provided based on

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the Claims in '488 application of how these limitations would be suggested to one of skill in the art in viewing only those claims.

Thus, if one practices the inventions of Claims 1, 10 and 15 of the instant application, they do not infringe Claims 1 and 10 of the '488 application. Accordingly, the obviousness-type double patenting rejection is not well-founded and should be withdrawn. As demonstrated above, a proper analysis has not been done in the rejection to establish a prima facie obviousness rejection. The MPEP is clear that for an obviousness rejection, the claims in the instant application cannot be used as roadmap for eliminating and modifying limitations in the claims of the '488 application. The rejection relies on just such a roadmap combined with conclusory incorrect statements. Applicant respectfully requests reconsideration and withdrawal of the obviousness-type double patenting rejection in view of the '488 application.

Provisional Double Patenting Rejection in View of U.S. Patent Application Serial No. 10/687,459 (the '459 application).

The rejection stated in part "The subject matter in the instant application is fully claimed in the reference copending application and would be covered by any patent that granted on that copending application."

Applicant respectfully traverses the provisional obviousness-type double patenting rejection. The above statement is in error and is indicative of an incorrect level of obviousness analysis. The MPEP is clear that in an obviousness-type double patenting rejection the requirements of a general obviousness rejection must be adhered to. Here, the claims in the instant application have been used as a guideline to dissect and eliminate limitations from the claims of the ' 459 application, which is an improper form of analysis.

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Each of the independent claims in the '459 application includes a limitation similar to

> receiving a new authenticated rights locker access request and a Web page with one or more clickable links in response to said sending

None of the claims in the instant application recite receiving two elements and in particular receiving a Web page. Accordingly, the rejection must provide some rationale based on the level of skill in the art to eliminate the receipt of the Web page. This has not been done.

Further, when the receipt of the Web page is eliminated, the claims of the '459 application no longer work for their intended purpose, because the claims include

> receiving an indication of a user selection of one of said one or more clickable links;
> sending an authenticated digital content request associated with said one of said one or more clickable links to a digital content repository;

Each of these elements requires the clickable links in the Web page and so elimination of the Web page would eliminate the clickable links and these two elements would no longer work. This is clear evidence that the Claims of the instant application are being used as a roadmap to dissect the claims in the '459 application, which is impermissible, and even when that is done the fact that the '459 application would no long work for its intended purpose is being ignored. The superficial level of analysis in this rejection goes against the requirements of the MPEP and so fails to make a prima facie obviousness rejection. Consequently, the provisional obviousness-type double patenting rejection is not well founded at any level. Applicant respectfully requests reconsideration and withdrawal of the provisional double-patenting rejection in view of U.S. Patent Application Serial No. 10/687,459.

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PAGE 8/17 * RCVD AT 10/10/2007 6:11:53 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/14 * DNIS:2738300 * CSID:831 655 0888 * DURATION (mm-ss):05-20

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§ 102 Rejections

Claims 1 to 100 stand rejected under 35 U.S.C. §
102(b) as anticipated by U.S. Patent Application
Publication No. 2004/0024652, hereinafter referred to as
Buhse. The rejection fails to consistently identify in
Buhse what is considered a user device and then demonstrate
that each of the processes cited in the Claims are
performed on that device. Rather, as demonstrated below,
the rejection takes pieces from various elements of Buhse,
which are not described by Buhse as a user device and then
recombines the disparate elements to read on Applicant's
inventions. This is an improper level of analysis for an
anticipation rejection.

Applicant respectfully traverses the anticipation
rejection of Claims 1, 20, 39 and 58. Paragraphs [0173] to
[0190] of Buhse are cited in the rejection as teaching
exactly a user device, i.e., ",on a user device (pars. 173-
190)," as recited in these claims. This portion of Buhse
describes an "Order Management System (OMS)." Therefore,
to teach the same invention as recited in Claims 1, 20, 39
and 58, the order management system of Buhse must perform
each of the processes recited in Claims 1, 20, 39 and 58.
Moreover, this interpretation of a user device is not
supported by any express teaching in Buhse.

The rejection also cited Paragraphs [0160] to [0172]
of Buhse as teaching "determining, on said user device,
enrollment authentication data." These paragraphs do not
describe any action taken on the OMS, which was identified
as the user device and instead recite:

> [0160] The RLC 104 (and OMS 105) can advantageously record
> consumer preferences. This information can be provided by the
> retailer for recording in the RLC. A fuzzy logic matching
> capability in conjunction with catalog searches can make helpful
> product suggestions and help direct the consumer. In addition, a
> central play list store allows the consumer access to their
> personal play lists from any device, as well as play list sharing
> operations through OMS 105.

> [0161] The rights locker can also integrate with 3rd party locker
> systems. Additionally, the system can support rights expression
> languages such as the Open Digital Rights Language (ODRL) and

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eXtensible rights Markup Language (XrML) in order to facilitate DRM neutral packaging processes and the transfer of rights between different DRM platforms.

[0162] RLC Flowchart:

[0163] FIG. 6B is a flow chart of an exemplary algorithm to perform the RLC function. The RLC processes requests from other components.

[0164] In response to a create request, the RLC creates a new end-user RLC account using the account ID provided.

[0165] In response to an account update request, the RLC edits the specified user account, updating the rights usage information with the supplied data.

[0166] In response to a rights information request, the RLC returns the specified user account information to the requestor.

[0167] RLC Messages and Requests:

[0168] The RLC typically supports the following messages and requests.

[0169] Update Rights: The OMS 105 updates the RLC 104 with the details of a rights transaction. This can be the result of a retailer purchase, secondary rights generation, or a 3rd-party update (e.g.: side-loaded rights from a physical retailer).

[0170] Request Rights: The OMS 105 requests information necessary to generate secondary rights.

[0171] Create Rights Locker Account: OMS 105 requests the creation of an account on behalf of a consumer.

[0172] Rights Locker Account Maintenance: CLI 101 requests of RLC 104 the creation, update, or deletion of a rights locker account (as a CRM operation).

This section describes actions by a rights locker component (RLC) and not actions by the OMS. Thus, the definition of the user device has changed from one claim element to the next. Moreover, these sections do not describe "enrollment authentication data" or determining such data. The RPC is described as processing requests from other components, i.e., a create request, an account update request, and rights information request. Such requests fail to suggest or teach anything concerning enrollment authentication data or the determination of such data.

The erroneous level of analysis is further demonstrated by considering the next element of these claims,

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sending, from said user device, a rights locker
enrollment request . . . comprising said enrollment
authentication data.

Thus, according to the rejection, for consistency with
the claim language that which was determined by the RLC is
next sent from the user device in a rights locker
enrollment request. However, the rejection is not
consistent. The rejection maintains that this process is
taught by Buhse paragraphs [0123] to [0135], which state:

[0123] C. Account Management System (AMS)

[0124] FIG. 5A schematically illustrates in context a preferred
Account Management System (AMS) 103 composed of an Account
Management Gateway (AMG) 501 and an Account Management Component
(AMC) 304. The AMG 501 serves as a bridge between the AMC 304 and
the rest of the system. The AMG inputs include subscription
information, requested content information, and catalog
information. The outputs include subscription status, account
maintenance information, and other information sent to the OMS
105. The AMG is an algorithm in software programmed on a digital
computer that serves as a gateway for client customized use of
the AMC 304. The AMG is connected to the OMS 105, the
subscription database 305, the AMC 304, and the OCC 102. It can
also be connected to the CLI 101.

[0125] The Account Management Gateway (AMG) 501 provides an
abstract interface between the system and the Account Management
Component (AMC) 304 via adapter 502. This interface isolates the
system from changes in the AMC 304, prevents system-specific
changes to the AMC 304, and allows multiple Account Management
Components.

[0126] The second main component of the AMS is the Account
Management Component (AMC) 304. The AMC is an online subscription
and account management system. It stores information about
consumer accounts, and creates and administers subscription
plans, as well as enforcing the business rules of subscription
plans.

[0127] The AMC 304 processes Consumer purchases and
subscriptions. It can store Consumer purchase information,
typically including: Consumer ID, purchased product, pricing, and
more. The AMC processes initial account registration, update,
renewal, suspension and auto-renewal for each Consumer or Client.
It also can handle order cancellation for either subscriptions or
purchases.

[0128] The AMC 304 sends the subscription account information to
the OMS 105. For subscription purchases, it manages flexible
business rules including time-based, group-based, quantity-based
and other customized subscription models. The AMC is capable of
processing account financial clearing, if necessary.

[0129] The AMC 304 is a centralized location for managing account
information. It is capable of managing complex subscription
plans. Via the AMG 501, the system can integrate multiple account

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management systems, allowing the support of existing customer subscription management and accounting systems. The Client maintains full ownership of existing accounts and the associated data. The client or system manager receives only a Consumer ID number. The AMC manages the entire subscription system.

[0130] The inputs to the AMC 304 are customer identification and account information, requests to create edit or delete customer accounts, subscription purchase, edits, or cancellations, and records of purchased products along with product information typically including pricing information. All inputs can be provided to the AMC via the Account Management Gateway. The AMC can be an algorithm in software programmed on a digital computer that executes database type storage an retrieval operations. Optionally, the AMC utilizing heuristic methods, such as fuzzy logic, can develop and report customer preferences and buying patterns. Outputs can include customer data, customer purchase statistics and preferences, subscription information, and purchase details.

[0131] The Account Management Component (AMC) 304 contains the business logic of the subscription offerings according to the client subscription system 504 via an adapter 502, and maintains the status of each subscribed consumer. The AMC can be implemented using a 3rd-party product such as Sandlot EclipseNet.

[0132] AMC Flowchart:

[0133] FIG. 5B is a flow chart of an exemplary algorithm to perform the AMC function. The AMC processes requests through the Account Management Gateway (AMG). The AMG isolates changes in AMC from the rest of the system, and allows supporting client-owned accounting systems, if required, without changing the system architecture.

[0134] Requests to create, delete, or update an account are processed internally by the Account Management Component. This process maintains the end-user accounts serviced by the system.

[0135] Purchase and subscription requests, and subscription fulfillments, are internally processed by the AMC. The AMC indicates to the requestor (normally OMS) whether the account holder is authorized to have the requested content. The business rules associated with the content and for the corresponding client, e.g.: content provider, are maintained within AMC.

Again, these sections fail to teach any actions taken by the OMS, which was identified as the user device in the rejection, and fail to teach sending a request that includes anything determined by the RLC. Rather, these sections teach that "The outputs include subscription status, account maintenance information, and other information sent to the OMS 105."

Thus, the explicit claim limitations have been ignored. Rather than sending something from the OMS, this section teaches sending something to the OMS, the exact

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opposite of the claim language. Further, what is being sent is not anything determined using the RLC. The rejection simply finds some elements with names similar to elements in the claims and then mixes and matches these elements from Buhse.

The claims relate elements in the different processes by using "said" or "the," so that the same element is being referred to in the different processes. However, the definition of an element in the claims changes in the rejection depending on which process is being considered in the rejection. The inconsistent treatment of claim elements is improper. Further, the elements relied upon in Buhse demonstrate that Buhse fails to teach the claimed inventions in the same level of details as recited in the claims.

The MPEP is unequivocal that this level of analysis cannot support an anticipation rejection. The MPEP directs:

> TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM
>
> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.". . . . < "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required.

MPEP § 2131, 8th Ed., Rev. 5, p. 2100-67 (August 2006). It is noted that this directive stated the claim element "**must be**" shown in as complete detail and arranged as required by the claim. This is not a permissive standard, but rather one that the rejection is required to comply with.

The anticipation standard in the MPEP does not permit extraction of teachings of different elements of Buhse, e.g., from the OMS, RLC and AMC, and recombining and

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redefining the actions performed by those elements, because such a modification violates the "arranged as required by the claim" requirement. Also, the MPEP anticipation standard does not permit ignoring explicit claim limitations, which violates the "in as complete detail as is contained in the claim" requirement. As demonstrated above, the rejection violated these requirements and so a prima facie anticipation rejection has not been made.

As demonstrated above, the rejection takes pieces from different parts of a system and recombines those pieces according to Applicant's claim language and not any teaching in Buhse. Moreover, Buhse shows that the pieces selected are on a system that is separate and distinct from the user devices as illustrated in Fig. 1A of Buhse. Thus, Buhse teaches away from Applicant's invention as recited in each of Claims 1, 20, 39 and 58 that recite a user device and structure and operations on such a device. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of each of Claims 1, 20, 39 and 58.

Applicant respectfully traverses the anticipation rejection of each of Claims 2 to 9, 21 to 28, 40 to 47, and 59 to 74. Each of these claims distinguishes over Buhse at least for the same reasons as the independent claim from which it depends. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of each of Claims 2 to 9, 21 to 28, 40 to 47, and 59 to 74.

Applicant respectfully traverses the anticipation rejection of each of Claims 10, 29, 48 and 75. Again Paragraphs [0173] to [0190] of Buhse are cited in the rejection as teaching exactly a user device, i.e., ", on a user device (pars. 173-190)," as recited in these claims. This portion of Buhse describes an "Order Management System (OMS)." Therefore, to teach the same invention as recited in Claims 10, 29, 48 and 75, the order management system of Buhse must perform each of the processes recited in Claims 10, 29, 48 and 75. Moreover, this interpretation of a user

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device is not supported by any express teaching in Buhse.
Buhse refers to user devices as communications from a
consumer.

The OMS and RLC as described in paragraphs [0154] to
[0158] and [0173] to [0188] are cited as determining the
digital content specification and the associated
authenticated rights locker access request. These sections
of Buhse fail to describe a digital content specification.
Since these sections of Buhse fail to consider a digital
content specification, these sections cannot describe any
authenticated rights locker access request associated with
such a specification. This alone is sufficient to overcome
the anticipation rejection.

The erroneous level of analysis is further
demonstrated by considering the next element of these
claims,

> sending, from said user device, said
> authenticated rights·locker access request and said
> digital content specification.

The rejection maintains that this process is taught by
Buhse paragraphs [0123] to [0135], which were quoted above.
Again, these sections fail to teach any actions taken by
the OMS or the RLC of Buhse, which was identified as the
user device in the rejection and doing the determination
process, and fail to teach sending a request that includes
anything determined by the RLC and OMS. Rather, the
section teaches that "The outputs include subscription
status, account maintenance information, and other
information sent to the OMS 105." Thus, the explicit claim
limitations have been ignored. Rather than sending
something from the OMS, this section teaches sending
something to the OMS, the exact opposite of the claim
language. Further, what is being.sent is not anything
determined using the RLC and the OMS. In addition, there
is no teaching of sending a digital content specification.

The above quotations from the MPEP are incorporated
herein by reference. Applicant respectfully requests

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reconsideration and withdrawal of the anticipation rejection of each of Claims 10, 29, 48 and 75.

Applicant respectfully traverses the anticipation rejection of each of Claims 11 to 14, 30 to 33, 49 to 52, and 76 to 87. Each of these claims distinguishes over Buhse at least for the same reasons as the independent claim from which it depends. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of each of Claims 11 to 14, 30 to 33, 49 to 52, and 76 to 87.

With respect to Claims 15, 34, 53 and 88, the rejection cited yet again paragraphs [0173] to [0190] [0154] to [0158] and [0123] to [0135]. Applicant respectfully traverses the anticipation rejection of Claims 15, 34, 53 and 88. The above comments with respect to Claims 10, 29, 48 and 75 are directly applicable to these claims also and will not be repeated, but are incorporated herein by reference. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of each of Claims 15, 34, 53 and 88.

Applicant respectfully traverses the anticipation rejection of each of Claims 16 to 19, 35 to 38, 54 to 57, and 89 to 100. Each of these claims distinguishes over Buhse at least for the same reasons as the independent claim from which it depends. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of each of Claims 16 to 19, 35 to 38, 54 to 57, and 89 to 100.

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Claims 1 to 100 remain in the application. For the foregoing reasons, Applicant(s) respectfully request allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant(s).

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office, Fax No. (571) 273-8300, on October 10, 2007.

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Respectfully submitted,

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